

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

APPEAL UNDER SECTION 109 No 5 of 1994

with

CIVIL APPLICATION No 32 of 1994

For Approval and Signature:

Hon'ble MR.JUSTICE R.BALIA.

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1. Whether Reporters of Local Papers may be allowed to see the judgements?
2. To be referred to the Reporter or not?
3. Whether Their Lordships wish to see the fair copy of the judgement?
4. Whether this case involves a substantial question of law as to the interpretation of the Constitution of India, 1950 of any Order made thereunder?
5. Whether it is to be circulated to the Civil Judge?

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AMRUTANJAN LIMITED

Versus

MEHTA UNANI PHARMACY &CO.P.LTD

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Appearance:

1. APPEAL UNDER SECTION 109 No. 5 of 1994  
MR GN SHAH for Petitioner  
MR YJ TRIVEDI for Respondent No. 1  
NOTICE SERVED for Respondent No. 2
2. CIVIL APPLICATION No 32 of 1994  
MR GN SHAH for Petitioner  
MR YJ TRIVEDI for Respondent No. 1  
NOTICE SERVED for Respondent No. 2

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CORAM : MR.JUSTICE R.BALIA.

Date of decision: 13/08/98

ORAL JUDGEMENT

1. This appeal is against order dated 9th March 1994 passed by the Assistant Registrar of Trade Marks rejecting the application for review of its earlier order dated 4.5.92.

2. Heard learned counsel for the parties. The facts giving rise to this appeal may be noticed in brief.

3. The appellant is a company incorporated under the Companies Act. It carries on the business of manufacturing and selling of pharmaceutical goods, particularly cough mixtures, skin ointment cold-rub, pain-balm and other pharmaceutical goods. One of its better known product is Amrutanjan pain-balm. It is also manufacturing and trading in another product styled as ANOLEUM cold rub for coughs and colds. The mark ANOLEUM has been registered with effect from 29.1.62. However, according to the appellants it is marketed since before 1962 and the product is described as ANOLEUM cold rub. It is also being advertised as such widely. The respondent company has been granted registration of word COLDRUB under Trade Mark and Merchandise Act, 1958, under application No. 447643 in class 5. The application was filed by M/s. Mehta Unani Pharmaceuticals & Company, a firm on 2.1.1986. The registration of mark was sought on the basis of user of the impugned word as trade mark since 1970. The application was accepted subject to Trade Mark Application No. 329747 and Application No. 407651 vide communication dated 13.2.1989, in pursuance of which the application was advertised under Section 21(1) of the Act of 1958 which read:

"COLDRUB

447,643. - January 2, 1986. MEHTA UNANI  
PHARMACY & CO. PVT. LIMITED, trading as MEHTA  
UNANI PHARMACY & CO., Amruthmanthan House,  
Sardar, Chhatralaya Road, Rajkot-360 001;  
Manufacturers and Merchants. User claimed since  
the year 1970. To be Associated with No.  
329,747(727)v and another. (BOMBAY).

Ayurvedic medicinal and pharmaceutical  
ointments."

4. Though the advertisement referred to association with 'another', it did not disclose another association

number.

5. On publication of the application, the appellants lodged their opposition with the Registrar on Form T. 5 on 13.7.1989, objecting to the registration of impugned mark 'COLDRUB' on very many grounds. The objections raised by the opponents has been summarised by the Assistant Registrar in his order dated 4.5.92. They are reproduced hereinbelow:

- "1. That the opponents are manufacturers of famous AMRUTANJAN PAIN BALM since last many years and are the Registered Proprietors of Trade Mark Nos. 8906 and 8907 since 1942. In the year 1962 they have started another product under the name and style of ANOLEUM COLDRUB for Cough & Colds and are the registered proprietors of the trade mark ANOLEUM under application No. 207076 dated 29th January, 1962, under application No. 256558 dated 6th May 1969 and under application No. 256676 dated 12th May 1969.
2. That since the year 1962 the product under the brand name ANOLEUM is described as COLDRUB and the opponents have not used any other expression for their product.
3. That opponents' another application under No.414272 dated. 12th December, 1983 has been accepted for publication in the Trade Marks Journal subject to agreeing for disclaimer of the descriptive word COLDRUB.
4. That the applicants are known to the opponents closely as adversary in several legal proceedings since 1966, and are the registered proprietors of a trade mark ATMAMANTHAN (word per se) under application No. 265260 in class 5 dated. 16th November, 1970.
5. That the applicants claim of registration relating to the word mark COLDRUB, basing their claim on their earlier registration No.329747, is not correct as this registration under the label mark is a composite mark consisting of other different features namely word ATMAMANTHAN and Devi of Oil Lamp.
6. That the claim of the applicants that their impugned mark COLDRUB is an invented, distinctive, not descriptive is in correct.

7. That the applicants claim of the proprietorship in the impugned mark cannot be entertained in view of the fact erstwhile partnership firm "Mehta Unani Pharmacy Co." has not transferred its assets to the private limited company i.e., the applicants herein under section 44(2) of the Act.
8. That the applicants themselves have accepted the fact that the expression COLDRUB is a purely descriptive term and the use of a descriptive term therefore, cannot acquire the status as a trade mark for the goods in question.
9. That the word COLDRUB is a public property belonging to the entire mankind and the applicants are trying to acquire exclusive right over it which cannot be termed as a trade mark."

However, after referring to certain other proceedings between the parties by embarking on considering the opposition and the application on merit, the learned Asst. Registrar confined his consideration only to the question whether the word 'COLDRUB' is descriptive word and cannot be allowed to be termed as a Trade Mark and is not eligible to be registered as Trade Mark. It is apparent from his statement :

" the only objection that appears to have taken by the opponents towards the registration of the impugned mark is that the word COLDRUB is a descriptive word and cannot be allowed to be termed as a Trade Mark."

Again, the learned Assistant Registrar after reaching conclusion that the impugned mark is not inherently adapted to distinguish the goods, the impugned application shall proceed to registration only in Part B of the Register and not in Part A of the Register, stated that no other point/objection has been raised by the opponents in their pleadings. By considering this objection as to the nature of the mark, learned Assistant Registrar had reached the following conclusions; viz., the word COLDRUB is not a dictionary word, hence it is invented word; that the word COLDRUB is inherently not distinctive; the word COLDRUB is not inherently incapable of distinguishing the goods in question and hastened to add that he should not be misunderstood that 'the word COLDRUB is not inherently incapable of distinguishing' to mean that the word COLDRUB has inherent capability or

capacity to distinguish the subject goods. The mark COLDRUB attained sufficient capacity to distinguish the goods in question on account of voluminous use and the extensive publicity given to it which is established by evidence filed by the applicants in support, by taking into account the use of mark after the date of application. That word COLDRUB is not required to be used by other traders on similar goods legitimately for their use in their trade.

Along with these findings learned Asst. Registrar also observed considering the claim of user of COLDRUB made by opponents:

"The word COLDRUB was first applied for registration along with word ANOLEUM by the opponents in the year 1983 by way of filing an application under No. 414272 dated 12th December 1983. Prior to this the opponents have not adduced any convincing or unimpeachable evidence about the use of the word COLDRUB, as a descriptive word, along with their registered trade mark ANOLEUM."

Referring to advertisement cuttings, it was observed, "no dates are printed on these cuttings". The learned Registrar also considered the issue of 'Manohar Kahaniam' dated January 1977 and observed it is clearly written in this respect that it is a new product of the opponents. These observations were made to reject the claim of opponents of using word COLDRUB describing the nature of goods in connection with merchandising their product known as ANOLEUM since 1962 and gave credence to the applicant's contention that opponents have introduced the word COLDRUB along with the registered mark ANOLEUM with a view to cause damage to the applicant's trade for the first time in the year 1988.

6. On the aforesaid precincts while rejecting the claim of opponents of the user of the word COLDRUB in describing their product known as ANOLEUM since 1961 i.e. to say before 1970 and giving credence to the user of the word COLDRUB by opponents only after filing of application with a view to cash on the mark used by the applicants which has acquired sufficient distinctiveness, the opposition was rejected and the application was granted vide order dated 4/5/92.

7. In the first instance, opponents filed a review petition before the Assistant Registrar. Review of the order was sought on the ground that the same suffers from

certain patent errors apparent from record; inviting attention to various errors which according to applicant were apparent.

8. The Tribunal rejected all the contentions on the ground that the same would require reappreciation of evidence, and therefore would not fall in the category of grounds which would justify reviewing the order dated 4.5.92 taking the provision of Order 47, Rule 1 of C.P.C. as a guideline for the ambit and scope of power of review by Registrar of its orders under Section 97(c) of the Act, observing that all these issues can be raised in appeal and not by way of review application.

9. After hearing both the learned counsel and perusing the material placed before me by way of two paper books containing the material that was before the Asst. Registrar, I am of the opinion that assuming the scope and ambit of power of review under Section 97(c) is circumscribed by and is limited to the grounds of review that can be raised under Order 47, Rule 1, C.P.C., the order rejecting the review was not justified.

10. A mistake or error apparent on the face of record is one of the grounds on which a person consider himself aggrieved with a decree is entitled to ask for review. Assumption of certain fact situation contrary to material on record and without taking into consideration the evidence that has been produced on the assumed ground that there is no evidence to that effect available on record would constitute an error apparent on the face of record to get jurisdiction to review the order. In *North West Frontier Province v. Suraj Narain Anand* reported in 1949 PC 112 it was observed that when a judgment proceeds on an erroneous assumption of fact, review is permissible.

11. So also where an order does not deal with or determine an issue raised by the parties, it amounts error apparent on the face of record requiring review on that ground. Reference may be made to *Moran Mar Basselios Catholicos and anr. v. Most Rev. Mar Poulouse Athanasius and ors.* reported in AIR 1954 SC 526 wherein omission to try material issue was held to be a ground for review. The fact that ultimate decision on that issue may not result in alteration of judgment does not make it any less amenable to review because deciding on merit would entail a detailed enquiry and evaluating rival contentions.

12. Mere erroneous appreciation of evidence or a

conclusion drawn from evidence from record one way or other may not furnish a ground for review, but assuming that evidence does not exist and proceeding to decide a question of fact on that basis would certainly bring the case within the purview mistake apparent on the face of record. The fact that on finding that evidence assumed to be nonexistent do exist or is apparently contrary to what it actually states it would require reappreciation of entire evidence on review being granted would not make the order any less irreviewable. It may be stated that review by the same authority in that sense envisage two stages of considerations. First whether order requires to be reviewed because of one or more grounds exist, which entail review of the order. It is on reaching this conclusion that second stage comes of considering the case on merit in the light of error noticed in first stage. Its effect on ultimate decision is the second stage. Once at first stage it can be said that order suffers from error apparent from record, which require order to be recalled and case reconsidered, the inhibition of appreciating evidence as a consequence of recalling first order does not come in the way. For example if the Tribunal has not decided an issue, while deciding a case, and this fact is brought to its notice, the order is to be reviewed. Now for deciding the left out issue, the lis may have to be tried de novo. The fact that allowing review will result in trial de novo, cannot be a ground for refusing to exercise power of review. While Civil Procedure Code envisages two separate stage viz., grant of review by recalling the order, and then decide the case afresh, exercise of such power in other proceedings both consideration may take place simultaneously.

13. As will be presently noticed, in the present case, ample ground emanate from the two orders read together that the petition for review could not have been rejected on the spacious ground that these contentions can be raised in appeal. It has already been noticed above in brief narration of facts that the learned Asst. Registrar has summarised the grounds of opposition as per the notice of opposition lodged on 13.7.89 as reproduced above. Yet, on the closing phase of the order, the Asst. Registrar excuses himself from deciding those issues by observing that no other point/objection has been raised by the opponents in their pleadings. One does not have to see further to find a mistake apparent on the face of record. Once review is granted the inhibiting of appreciating evidence and reaching of conclusions on the basis of material which is already on record cannot be invoked for the purpose of throwing review petition out.

14. It has been specifically urged that the Tribunal has erroneously assumed the conclusion that respondent applicants had been using the mark since 1970, the attention was invited to affidavit dated 30.9.86 part of which has been referred to in the application for review itself. In that affidavit it has been stated by the present applicant:

"I say that Atmamanthan Rub Ointment and Atmamanthan Cold Rub is one and the same product and the Bills referring to Atmamanthan Rub Ointment for the period 1974 to June 1978 are in fact in respect of 'Atmamanthan' 'Cold Rub'.

We may also state that in the Invoice even after 1976 the word "Atmamanthan Rub Ointment" was continued to be used on account of old stocks of invoices being used by our clients.

I say that the said Amritmanthan Agencies had printed their own invoices and in the said Invoices for the year 1976 onwards till today the item "Atmamanthan Cold Rub" is mentioned.

This clearly shows that during the period from year 1976 onwards the label Atmamanthan Cold Rub was used by the Defendants in respect of their products."

In connection with user of COLDRUB by the applicants as a part of a registered trade mark held by them under T.M. No. 329747, learned Assistant Registrar has proceeded on the assumption in his order dated 4.5.92 'no disclaimer condition with regard to the word COLDRUB has been put by the Registrar of Trade Marks. It is correct that the applicants have admitted that the word COLDRUB is a descriptive term'.

15. This assumption has been shown to be contrary to record by drawing the attention of the Registrar to the letter dated 10.7.1973 in response to Registrar's objection to accept the application No. 329749 in class 5. The letter dated 10.7.1978 addressed to Registrar of Trade Marks, Bombay, reads:

"With reference to your letter bearing No. U-1/4970 dated 3rd July, 1978, we have to state as under:-

1. . . . .



2. . . . .
3. . . . .
4. . . . .
5. The applicants agree to disclaim the words "COLDRUB" appearing in the mark.
6. The applicants goods are called for and sold by the name "ATMAMANTHAN" and device of Oil Lamp, which mark has already been registered by the applicants."

This disclaimer to use words 'COLD RUB' as trade mark is in response to objection raised by the Registrar. Apparently the Assistant Registrar has erroneously assumed on its own that no disclaimer condition with regard to the word COLDRUB has been put by the Registrar of Trade Marks'.

Attention has also been invited to letter dated 24.3.79 which was addressed to M/s.Crawford Bayley & Co. in reply to their notice of alleged infringement and passing off VICKS VAPORUB trade mark owned by M/s. Richardson Marrell Inc. and Richardson Hindustan Ltd. Stating in unequivocal terms:

"Our clients' trade mark ATMAMANTHAN forms the main and essential feature of the trade mark and the said mark stands already registered under the provisions of Trade and Merchandise Marks Act. Even the label as a whole as used has been accepted for registration subject to the disclaimer of the word "Cold Rub". It is pointed out that no exclusive right could be claimed in the words "Rub" or "Cold Rub" which are purely descriptive and laudatory of the goods in question."

16. The assumption of no disclaimer to use of word 'COLDRUB' by the respondent is on the face of record erroneous. This is not a finding on appreciation of evidence but on an erroneous assumption of fact, which has resulted in entirely different vision of the controversy about the user of word COLDRUB by both the parties whether in attributing intention to the opponents or assuming a long and uninterrupted user by the applicant resulting in acquiring distinctiveness or capable to distinguish the goods of applicant from the goods of other manufacturers. This assumption had also great bearing on the conclusion reached by the Registrar that the word COLDRUB has been and is being used by the applicant as a trade mark resulting in acquisition of distinctiveness of becoming capable of distinguishing the

goods of applicant from those of others.

17. The aforesaid discussion leads to irresistible conclusion that the order dated 4.5.92 suffered from errors apparent on face of record and was required to be reviewed. Once this conclusion is reached, further inhibition that fresh decision on merits would call appreciation of evidence which may result to the same or other conclusion is not relevant at the stage of considering the question whether the order is liable to be reviewed or not.

18. Having reached this conclusion that the order dated 4.5.92 suffer from error apparent on the face of record, ordinarily, appellate court would not embark upon reappreciating the entire controversy and to come to its own conclusion but would require original authority to decide the application afresh. However, it is urged by learned counsel for the appellant that this course may not be necessarily conducive in the present case inasmuch as even without going into the questions requiring appreciation of facts, the application can be decided on questions of law emanating from undisputed facts. Firstly it was urged that the appellant has specifically raised a ground in his opposition that registration of the impugned trade mark is sought in association of already existing registered trade mark No. 329747(747) whose registered proprietor is M/s. Mehta Unani and Pharmaceutical Company, a partnership firm, and proprietor of the trade mark in question has not transferred its assets to the Private Limited Company, the applicants, in whose favour the impugned order has been made. Specific assertion in the opposition in this connection in para 14 has been made alleging that there is nothing to show that the partnership firm, Mehta Unani Pharmacy and Company, has transferred its assets to Private Limited company. That the firm Unani Pharmacy and Company does no longer exist and the Private Limited company is not yet registered proprietor of the Trade Mark 329747. .... The opponents submit that as on date the applicant firm, Mehta Unani Pharmacy and Company, alone continues to be the Registered proprietor in the records of Trade Marks Registry. Thus applicant a limited company not being proprietor of registered trade mark No. 329747, it cannot seek registration of impugned mark in association thereof.

These averments in para 14 were replied as under:

"With reference to para 14 of the Notice of Opposition, we say and submit that the

Partnership firm M/s. Mehta Unani Pharmacy and Co. and necessary action has been taken to bring the name of M/s. Mehta Unani Pharmacy Co. Pvt. Ltd. on the register. We say that the opponents are only raising technical objections to harass us in one way or other."

19. In para 17 of the counter statement it was stated that applicants M/s. Mehta Unani Pharmacy and Co. Pvt. Ltd. and trading in the name of M/s. Mehta Pharmacy and Co. The constitution of the firm has been changed according to the rules and regulation of the Trade Marks Registry.

20. In substance, the contention of Mr. Rao is that the application was filed in the first instance on 2.1.1986 by the partnership firm known as M/s. Mehta Unani Pharmacy Private Limited. The trade mark, if assumed to exist, being a part of the assets of the firm unless transferred continues with the firm. There being no evidence that the firm has assigned its assets including the mark in question in favour of Private Limited Company, a distinct juristic entity, the application originally filed by the firm cannot be continued by company. Reference was made to Section 44 for the purpose buttressing the argument that the available evidence points to the continued ownership vesting in the firm and not in the company. The company having not made any assertion as to transfer of assets in its favour by the firm concerned, it cannot claim title to the mark and must be deemed to have admitted the assertions of fact about mark owned by the firm when application was made, and so far not transferred in favour of the company.

21. The second contention in this regard is that even assuming that the applicant is entitled to make this application, but once it is shown from the record and which is not disputed that the proprietor of the mark while pursuing application No. 329747 has specifically disclaimed the words COLDRUB appearing in the mark applied for registration and confined its claim to the proprietorship of the mark only to the extent it uses the name 'ATMAMANTHAN' and device of oil lamp' already registered in the name of the respondent applicant and reiterating the same stand on an objection being raised on behalf of M/s. Richardson Marrel Inc. and Richardson Hindusthan Ltd. that the registration mark is subject to disclaimer of the word COLDRUB and no exclusive right to use is claimed and can be claimed in words RUB or COLDRUB, it is not open to applicant now to acquire

exclusive right to use the word COLDRUB merely on the basis of user since then notwithstanding that other persons have already started using word COLDRUB on that premise. If this contention is to be accepted, remanding the case back to the Assistant Registrar would of academic interest.

22. Having carefully considered the aforesaid contentions, I am of the opinion that though the first contention may require some enquiry into facts, the latter contention leads to inescapable conclusion in favour of the opponents, making the further investigation into other aspects unnecessary for the present purposes.

23. The admitted premise is that when application No. 329747 in class 5 was made by M/s. Mehta Unani Pharmacy Company using words Cold rub as part of the said mark in response to objection raised by Registrar to its acceptability, the applicant in writing responded by disclaiming the words COLDRUB appearing in the mark. The fact that on raising of objection and agreeing with that objection about disclaimer of words COLDRUB appearing in the mark, the ultimate mark which was published in Trade Mark Journal continued to carry word COLDRUB, does not detract from the fact that neither the word COLDRUB could be treated as part or essential feature of that mark nor it gave any exclusive right to use word 'COLDRUB' to the holder of that mark under that registration. That being so, on the admitted position of the parties, as on the date, when the reply was given to the notice on behalf of M/s. Richards Marrel Inc. and another and affidavit was filed in those cases, as on the 15th day of January 1983, the applicant did not claim use of words COLDRUB as part of any of its mark, or to use it exclusively as word per se. In fact he himself took the position that the word being of more descriptive character can be used by anybody and everybody and is not capable of acquiring status of trade mark. Even according to finding of learned Asst. Registrar, the user of words COLDRUB along with its product ANOLEUM by the opponent is attributable not earlier than 1977-78 and not later than 1983. At any rate such claim was laid by the opponents, taking the dates referred to by the Assistant Registrar, at least three to eight years prior to the application filed by the present applicant. This is besides the fact that the opponent has produced a large number of documents in the form of manufacture record showing production of ANOLEUM since before 1970 contrary to inference drawn by learned Asst. Registrar that it was a new product coming in the market only in 1977 solely on the basis of impetus given in one of the advertisement in Manohar Kahaniayan but by

ignoring the advertisements with specific date of publishing in Journal dating from 1969 onwards with two certificates from the publishing agency certifying that the advertisement of ANOLEUM COLDRUB is being published since 1973. The fact remains that the opponent has started using word 'Cold Rub' in connection with merchandising his product ANOLEUM in a descriptive manner even as per the finding of the Asst. Registrar, much before the applicant laid claim to exclusive user of the words COLDRUB. In the face of his disclaimer to use word COLDRUB as part of his Trade Mark in response to objection by Registrar as early as in 1978, another presumptive edifice assumed by the Asst. Registrar fails to sustain itself that the word COLDRUB is not required legitimately by other traders in similar business for their legitimate use in their trade and that there is no evidence that the word COLDRUB is required to be used in other trades of similar goods except the claim of the opponents herein. The user of a common descriptive word at one time admitted by respondent, while nobody had claimed exclusive right to that word, it cannot also be said that the user of word COLDRUB by the opponents was with any oblique motive and to usurp the advantage generated by the applicants as a result of use of word COLDRUB. In fact at the point of time when, even as per finding of Asst. Registrar, the appellant has started describing its product anoleum as COLDRUB, in advertising its product, the applicant was himself trying to save his application by conceding that word rub or Cold rub is a common descriptive word which could be used by any one. No question of applicant having acquired any such distinctive reputation in use of word COLDRUB as mark to distinguish its product from others' goods arise.

Under these circumstances, the further conclusion is also inescapable that as on the date applicant had moved an application claiming his exclusive right to use the word COLDRUB on the basis of his proprietorship of the earlier trade mark containing the words COLDRUB in 1986, the opponent had already started using the word COLDRUB in association with its product ANOLEUM at a time when disclaimer of the applicant to the exclusive use of word COLDRUB as trade mark was in operation. Thus the application as well as the opponent were using the same word in respect of similar product as on the date when application was being moved and was being considered. The word COLDRUB was not a registered trade mark or property of either of the parties on that day so as to lay claim for exclusion of one by another.

24. In these circumstances, grant of an application

for registering a descriptive word in relation to goods which are treated by different persons, under the same name for sufficiently long duration would squarely inhibit the claim of the applicant under Section 11(1)(a) of the Act of 1958 and would also not be amenable to be considered as having acquired capability to distinguish the goods of the applicant on the basis of the use of word COLDRUB per se.

25. In that view of the matter, I am of the opinion, that on the existing facts itself, once the order dated 4.5.92 is held to be erroneous on the face of it liable to be reviewed and review application is granted, the opposition is liable to be upheld and the the application is liable to be rejected on this ground alone not requiring investigation into other questions whether the applicant was the prior user or the opponent was prior user of the word COLDRUB in relation to their respective products.

26. As a result, this appeal is allowed with costs. The impugned order dated 9.3.94 is set aside. The application for review of the order dated 4.5.92 is allowed. Consequently, the order dated 4.5.92 is also set aside and having heard learned counsel for the parties on the merit of the application, as discussed above, the appellants opposition to application is allowed and application No. 447643 dated 2.1.86 for registration of words COLDRUB as trade mark is rejected.

There shall be no orders as to costs.

(Rajesh Balia, J)